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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,949	11/25/2003	John B. Slate	11102.5.2	5873
23862	7590	01/09/2006	EXAMINER	
NYDEGGER & ASSOCIATES			HUH, BENJAMIN	
348 OLIVE STREET			ART UNIT	
SAN DIEGO, CA 92103			PAPER NUMBER	

3767

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/721,949	<b>Applicant(s)</b> SLATE ET AL.	
	<b>Examiner</b> Benjamin Huh	<b>Art Unit</b> 3767	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/25/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/25/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Figure 2, button retraction not automatic
- II. Figure 8, automatic with use of face cam and locking ring

With respect to the plunger

- IA. Figure 4-7, straight plunger
- IB. Figure 11 & 12, tapered plunger

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by

37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Neil Nydegger on 12/06/2005 at 1:40 pm a provisional election was made with traverse to prosecute the invention of species II with plunger IB, the automatic with use of face cam and locking ring with the straight plunger, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8 & 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention due to the fact that claim 8 refers to the tapered plunger and claim 9 is dependent off of independent claim 8.

### ***Priority***

This application discloses and claims only subject matter disclosed in prior Application No. 10/123898, filed 04/15/2002, and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit

of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. It is acknowledged that the application gains the benefit of the Patent Application 10/123898 for the filing date of 04/15/2002 which claims benefit of provisional patent application 60/283839 for the effective filing date of 04/13/2001.

### ***Information Disclosure Statement***

The information disclosure statement received on 11/25/2003 is acknowledged. The IDS meets the requirements of 37 CFR 1.97 & 1.98 and therefore references listed therein have been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 & 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Durrant (PCT/GB02/01683). Durrant discloses "a device for retracting a plunger through a fluid-filled chamber of a syringe" comprising a "injector body" seen as the device found on sheet 1 defining an axis, a locking ring 7 mounted on said injector body for rotation about said axis to secure the syringe to said injector body, a gripper 16 having an aperture, said gripper being mounted on said injector body and centered on said axis to receive the plunger 3 through said aperture, a means mounted on said injector body for selectively moving said gripper in response to a rotation of said locking ring between a first orientation wherein said gripper is substantially perpendicular to said axis to allow an axial movement of the plunger through said aperture to said gripper can be seen on sheet 1 where the "gripper" 16 is perpendicular to the plunger and a second orientation wherein said gripper is tilted relative to said axis to engage said gripper with the plunger to prevent axial movement of the plunger through said aperture relative to said gripper is stated on page 3 paragraphs 2 & 3, and a means for retracting the plunger through a predetermined distance in response to a rotation of said locking ring 9 when said gripper 16 is in second orientation is stated on page 3 paragraphs 2 & 3.

With regards to claim 2, the gripper is shaped as a ring with a circular band in figure 6.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Jost (Patent No. 6090080). Jost discloses an injector body defining an axis seen in figure 1 as 1, a locking ring 11 mounted on said injector body for rotation about

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said axis to secure the syringe to said injector body, a face cam 27 mounted on said locking ring for rotation therewith, and a means responsive to a rotation of said face cam for engaging and retracting said plunger which can be found column 2 line 63 to column 3 line 67.

### ***Allowable Subject Matter***

Claims 3, 4, 6, & 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose the claim of invention.

With regards to claim 3 & 6, the feature not disclosed is a means comprising a face cam mounted on a locking ring connected to a push rod which is in contact with a gripper which retracts a plunger in response to the rotation of the locking ring.

With regards to claim 4 & 7, a means for biasing said gripper into said first orientation can be seen as when the locking ring is "rotated" in the reverse direction in order to bias said gripper into the first orientation.

### ***Conclusion***

Another reference found disclosing a "device for retracting a plunger" was Ekins (Patent No. 2732102) which discloses a device in figure 4 and 5 which

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according to column 2 lines 11-19 show a "... retrogressive feeder means for retracting the feeding plunger ...".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Huh whose telephone number is 571-272-8208. The examiner can normally be reached on M-F: 9:00-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BHH

BHH



**MICHAEL J. HAYES**  
PRIMARY EXAMINER